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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,652	01/14/2002	Daniel F. Moore	09857-071001	1073
26161	7590	10/23/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			SHERR, CRISTINA O	
		ART UNIT	PAPER NUMBER	
		3621		

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/046,652	MOORE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cristina Owen Sherr	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 June 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-25 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to applicant's amendment filed June 30, 2006. Claims 3-5, 7-8, 11, 15-18, 20-25 have been amended. Claims 1-2 are currently pending in this case.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, drawn to a method for determining an opening price for a product traded in a trading system comprising, *inter alia*, detecting a lock/cross condition in the market, classified in class 705, subclass 37.
- II. Claims 22-25, drawn to a system for determining an opening price for products traded in a trading system a networked system comprising identification of oldest of interest, without regard to lock/cross condition, classified in class 705, subclass 35.

3. The inventions are distinct, each from the other because of the following reasons:

4. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention II does not require detecting the lock/cross condition. The subcombination (Invention I) has separate utility such as detecting the lock/cross condition.

5. The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

6. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

7. Applicant is further advised, that, in the event of choosing invention I, said invention I is also subject to an election of species.

8. Claims 1 and 14 are generic to the following disclosed patentably distinct species:

IA. Claims 2,3, and 15 are directed to a method for determining an opening price for a product traded in a trading system comprising, *inter alia*, detecting a lock/cross condition in the market wherein the products are financial instruments.

Other arguments concerning the merits of the claims are not addressed in this communication.

Applicant is advised that if the species require a different field of search (see MPEP § 808.02), then an election of species must be made in a timely manner.

Applicant is advised that if the species require a different field of search (see MPEP § 808.02), then an election of species must be made in a timely manner.

IB. Claim 4, directed to a method for determining an opening price for a product traded in a trading system comprising, *inter alia*, detecting a lock/cross condition in the market and wherein interest is all quote-generated and non-directed.

IC. Claims 5-6 and 20, directed to a method for determining an opening price for a product traded in a trading system comprising, *inter alia*, detecting a lock/cross condition in the market, and including executing any interest in a particular priority.

ID. Claims 7-9 and 17, directed to a method for determining an opening price for a product traded in a trading system comprising, *inter alia*, detecting a lock/cross condition in the market, and wherein interest exists at multiple price levels.

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IE. Claim 10, directed to a method for determining an opening price for a product traded in a trading system comprising, *inter alia*, detecting a lock/cross condition in the market, and wherein the sides of the market are an offer side and a bid side.

IF. Claim 11, directed to a method for determining an opening price for a product traded in a trading system comprising, *inter alia*, detecting a lock/cross condition in the market, and wherein executions occur at the price of book interest.

IG. Claims 12 and 17, directed to a method for determining an opening price for a product traded in a trading system comprising, *inter alia*, detecting a lock/cross condition in the market, and wherein after an execution, quote-generated orders are updated.

IH. Claims 13 and 19, directed to a method for determining an opening price for a product traded in a trading system comprising, *inter alia*, detecting a lock/cross

II. Claims 14, directed to a method for determining an opening price for a product traded in a trading system comprising, *inter alia*, detecting a lock/cross

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condition in the market, and including testing whether a lock/cross condition has been removed.

9. The species are independent or distinct because each may be utilized separately from the others. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

10. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

11. A telephone call was made to October 10, 2006 to request an oral election to the above restriction requirement, but did not result in an election being made, due to applicant's attorney being temporarily out of the office.

12. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

13. The examiner is provided with the art under 37 CFR 1.141 if claim(s) are allowed. The examiner must indicate which are readable upon the elected species.

13. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

14. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

15. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number is 571-273-2870. The Direct Office of the Commissioner of Patents and Trademarks, Washington, DC 20591-0000, is 571-272-8400.

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number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Cristina Owen Sherr*  
Cristina Owen Sherr  
Patent Examiner, AU 3621

*ANDREW J. FISCHER 10/16/06*  
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SUPERVISORY PATENT EXAMINER  
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.